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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,549	10/17/2000	Oleg B. Rashkovskiy	BKA.0006US	2613

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TROP PRUNER & HU, PC
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER	
BROWN, RUEBEN M	

ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/690,549	RASHKOVSKIY, OLEG B.	
	Examiner	Art Unit	
	REUBEN M. BROWN	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 47-57 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 47-57 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination

1. On March 7, 2008 the Board of Appeals & Interferences mailed a Decision on Appeal that reversed the 102 rejection of claims 47-50 & 52-57, as being anticipated by Rosser, (U.S. Pat # 6,664,261).

On pages 8-14, (Section B. of the ANALYSIS), the Board addressed the issue of whether Rosser discloses the claimed *'cache…to store said content and said advertisement'*. The Board concluded the Rosser does teach the instant claimed subject matter. In particular, with respect to Rosser's operation as a more conventional video recorder, (col. 5, lines 31-43), the Board wrote on page 13:

> Claim 47 is broad enough to permit the content and advertisements to be stored in different memories, as disclosed in Appellant's Specification (e.g., at 5:9-11). Thus, Appellant has not shown that the Examiner erred in finding that Rosser discloses a cache that stores content as well as advertising.

Furthermore, on page 14, the Board continued:

> Nevertheless, for the reason given above regarding "VCR" operation, Appellant has not persuaded us of error in Examiner's position that Rosser discloses "a cache...to store said content and said advertisement".

On pages 14-15, (Section C. of the ANALYSIS), the Board also addressed the issue of whether Rosser discloses the "update limitations". The Board concluded that based on the viewer profile technique, Rosser does teach that either a default advertisement(s) or advertisement(s) based on a match between the viewer profile and the targeting profile of the advertisement(s), will be downloaded and/or stored in the STB 44. However, on page 15, the Board wrote that Rosser did not teach that the stored advertisement(s) were updated.

> Appellant is therefore correct to argue "nowhere [in Rosser] is there contemplation that advertisement in particular might need to be updated over time and thereby automatically replaced" (Appeal Br. 11).

The examiner has specific knowledge of the existence of a particular reference or references that indicate non-patentability of the appealed claims. Therefore prosecution is re-opened, and a new art rejection on the merits is presented herein.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 47-50 & 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khoo, (U.S. Pat # 6,434,747), in view of Rosser, (U.S. Pat # 6,446,261) and Jernigan, (U.S. Pat # 5,233,423).

Considering claim 47, the claimed *'receiver to receive content, an advertisement'*, reads on the client 235, which receives and stores content media & advertising media, see Khoo; col. 5, lines 29-42; col. 6, lines 52-65 & Fig. 3. Khoo also more specifically teaches that client 235 comprises a Media Cache Service Module 410 that stores the content media and advertising, which are generated by server 225 and transmitted by the instant server 225 to the client 235; also see col. 8, lines 6-67 & Fig. 4.

'a cache, coupled to the receiver, to store the content and the advertisement', is met by the Media Cache Service Module 410 of Khoo, which stores audio/video data, including advertisements, col. 8, lines 6-67; col. 10, lines 41-67 & Fig. 4.

As for the claimed, *'update instructions'* and *'a shell, in the receiver, to find a place to insert the advertisement in the cached content before the cached content is to be output for display, such that the receiver receives an update for the advertisement and automatically replaces the advertisement using the instructions'*, Khoo teaches that the "customized advertising contains advertising commercials that are sequenced within the customized content in a predetermined order", col. 7, lines 25-37, which is different from *'...find a place to insert the advertisement'*.

Nevertheless Rosser, which is in the same field of customized advertising, teaches inserting different advertisements in video programs, based upon the attached category code, compared at least to the viewer usage profile data 120, col. 7, lines 45-58. Therefore the claimed *'shell'*, reads on the downstream LVIS system 46, which inserts a particular commercial within a particular video program based on the user profile and the profile of the instant commercial. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Khoo with the feature of finding a place to insert the advertisement in the cached content, at least for the improvement of inserting advertisements, not only in in-programming breaks, but also in different spots, such as when the customer turns on the TV, changes channels, or alters viewing parameters, etc., as taught by Rosser, see col. 4, lines 49-65.

Rosser also teaches that content and advertisements may be stored in the receiver device, col. 5, lines 40-43; col. 7, lines 45-58 & col. 13, lines 14-24.

However Khoo & Rosser do not explicitly teach that the *'stored advertisements are updated and automatically replaced'*. Nevertheless Jernigan, which is in the same field of endeavor of customized advertising systems, teaches the claimed subject matter, col. 3, lines 18-64.

In particular, Jernigan discloses that certain advertisements may be downloaded and stored in a customer's TV receiving equipment. Subsequently, the stored advertisements may be updated with new advertisement(s), col. 3, lines 18-32. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify the combination of Khoo & Rosser with the feature of updating stored advertisement(s), with new advertisement(s) as taught by Jernigan, (col. 2, lines 1-10) at least for the known desirable advantage of providing a particular customer with different advertisements, which would for instance promote different or newer products and/or services.

Considering claim 48, the claimed *'receiver to receive the update with a pointer, such that the receiver uses the pointer to store the update at a location'*, the *'pointer'* is broad enough to read on the identification information used to identify the advertisements in both Rosser & Jernigan.

Considering claims 49-50, the claimed *'marker'*, reads on the discussion in Rosser that the insertions are placed at particular points in the video programming in

order to appear seamless, col. 7, lines 40-45; col. 13, lines 22-34 & col. 14, lines 32-67 thru col. 15, lines 1-6.

Considering claim 57, Rosser discloses a set-top device 44.

4. Claims 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khoo, Rosser & Jernigan, further in view of Payton, (U.S. Pat # 5,790,935).

Considering claims 51-53, the instant claims are directed to storing a list of advertisements, in order to determine whether a particular advertisement has been already stored. However, even though Khoo discloses transmitting a list of customized media (wherein the customized list includes a list of advertising media) that is stored on a user terminal, see Abstract; col. 5, lines 35-50 & col. 8, lines 15-25, the reference does not explicitly discuss that the list is used in order to only store advertisements that have not been stored, as recited in claims 51 & 53. Nevertheless Payton, which is in the same field of customized programming, provides a teaching that local server(s) 28 (wherein there is a local server 28 for each subscriber) receives a recommended list (which corresponds with the customized media list of Khoo) but only downloads/stores those items that are not already locally stored, see col. 6, lines 1-20. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Khoo with the feature of only downloading/storing those items that are not already

previously stored as taught by Payton, for the desirable benefit of avoiding duplication, thereby conserving space on the storage device.

Even though Payton does not directly discuss that the downloaded items may be advertisement, since Khoo, Rosser & Jernigan already teach this feature, the combination of Payton would teach one of ordinary skill in the art to operate the receiver device to only download/store the advertisement(s) that are not already stored, which as discussed above obviates the problem of duplication, and meets the claimed subject matter.

5. Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khoo, Rosser & Jernigan, further in view of Ebisawa, (U.S. PG-PUB 2004/0111317).

Considering claims 55-56, even though the combination of Khoo, Rosser & Jernigan teaches that stored advertisements may be updated, the instant references do not teach receiving information about when to update the advertisement, and updating the advertisements on a periodic basis. Nevertheless Ebisawa, which is also in the field of customized advertising, Abstract & Para [0001-0002 & 0026] discloses periodically updating stored advertisements each time a game program is executed, or alternatively, daily, monthly or whenever the receiver/game system is turned on, see Para [0033]. Since the main program in Ebisawa, which controls the game system is downloaded from a server, see Para [0008 & 0031-0032] the claimed feature of, *'receive information*

about when to update advertisement' is met by the main program being received at the game system.

It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Khoo with the feature of directing the receiver system to periodically download advertisements, at least for the advantage of insuring the reception of new advertisements, on a regular basis, which avoids the use of obsolete advertisements, as discussed by Ebisawa, Para [0003].

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 47-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the specification nor original claims included the terms of cache and shell. Further the specification does not support a cache coupled to the receiver. Where in the specification is this coupling disclosed?

Claim 51 requires an "interruption", where is this taught in the disclosure?

Allowable Subject Matter

6. Claim 54 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and complies with 112 first paragraph.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Flickinger Teaches selectively storing advertisements on STB, Para [0066].

B) Pierson Teaches storing content and advertisements on a STB, Para [0032, 0060-0067].

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:
(571) 273-8300, (for formal communications intended for entry)
Or:
(571) 273-7290 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Reuben M. Brown/
Patent Examiner, Art Unit 2623

/Chris Kelley/
Supervisory Patent Examiner, Art Unit 2623

Wanda L Walker

WANDA L. WALKER
DIRECTOR
TECHNOLOGY CENTER 2600